

REMARKS

Claims 59-70 are pending in the instant application. On May 7, 2008 applicants' undersigned attorney, Robert Alderson, met with Examiner Weddington for an in-person Examiner's Interview. Applicant wishes to thank the Examiner for the courtesy extended to Mr. Alderson during the Examiner's Interview. During the Interview agreement was reached on all of the issues raised in the December 28, 2007 Office Action. Applicants provide below the positions raised by Mr. Alderson with respect to (1) obviousness-type double patenting (2) 35 U.S.C. §112, first paragraph, written description and (3) 35 U.S.C. §103 (a).

Applicants note that claim 59 is the only presently pending independent claim.

Claim 59 recites:

A method for abrading human or animal tissue comprising abrading the tissue with a bioactive material which comprises between about 30% and about 96% by weight of silicon dioxide oxide (SiO_2), between about 0% and about 35% by weight of sodium oxide (Na_2O), between about 4% and about 46% by weight calcium oxide (CaO), and between about 1% and about 15% by weight phosphorus oxide (P_2O_5), with the proviso that the tissue is not nail tissue.

Each of the bases for rejection referenced above are now addressed in turn.

Obviousness-Type Double Patenting Rejections

In the December 28, 2007 Office Action the Examiner rejected the pending claims on the ground of non-statutory obviousness-type double patenting based on U.S. Patent No. 7,141,520 ("the '520 Patent") and U.S. Patent No. 7,192,602 ("the '602 Patent"). The Examiner also provisionally rejected the claims for non-statutory obviousness-type double patenting based on U.S. Application Serial No. 10/673,596 ("the '596 Application").

Applicants respectfully traverse the Examiner's obviousness-type double patenting rejections based on the '520 and '602 Patents. The '520 Patent merely claims glass ceramics or methods for producing such glass ceramics. The '602 Patent merely claims silicate glass powder, processes for making such glass powder and products containing such silicate glass powder. As discussed during the Examiner's Interview, none of the claims of the '520 and '602 patents relate to the abrasion of human or animal tissue. Accordingly, applicants respectfully request that the Examiner withdraw this basis for rejection of the pending claims.

With respect to the '596 Application, applicants note that it is no longer pending. Accordingly, any double patenting rejection based on the '596 Application is now moot.

Written Description Rejection Under 35 U.S.C. §112, first paragraph

In the December 28, 2007 Office Action the Examiner rejected the claims under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. The Examiner alleged that the specification did not adequately describe the phrase "with the proviso that the tissue is not nail tissue."

In response, applicants respectfully traverse the rejection of the claims under 35 U.S.C. §112, first paragraph. As discussed during the Examiner's Interview, the specification clearly describes a variety of embodiments of the invention. More particularly, after describing various skin abrasion methods, paragraph [43] of the published specification specifically recites:

In addition to embodiments involving skin abrasion, the abrasives and methods disclosed herein are also appropriate for abrading other surfaces including but not limited to skin, scalp, fingernails, toenails, teeth, tongue and other body surfaces or body cavities of animals, and in particular, mammals such as humans.

Thus, the specification makes clear that the invention relates to several embodiments. The presently claimed invention specifically excludes one of those embodiments, namely abrasion of nail surfaces. During the Interview the Examiner agreed that paragraph [43], taken in the appropriate context, adequately supports the proviso language. Accordingly, applicants respectfully request that the Examiner withdraw the rejection of the claims under 35 U.S.C. §112, first paragraph.

Rejection Under 35 U.S.C. § 103(a)

In the December 28, 2007 Office Action, the Examiner rejected the pending claims under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,517,863 (“LaTorre”) in view of WO 00/76486 (“Ballantone”).

In response, applicants respectfully traverse the Examiner’s rejection under 35 U.S.C. § 103(a). During the Examiner’s Interview LaTorre was discussed at length. Applicants’ representative pointed out that LaTorre unequivocally teaches building up a layer of hydroxyapatite on the nail. The purpose of this layer is to harden and strengthen the nail and/or to fill in voids or cracks in the nail surface. LaTorre refers to the formation of such a layer more than a dozen times. (See, e.g., Col. 2, lines 43-45 and 48-54, Col. 3, lines 1-6, 27-36, 41-44 and 46-48, Col. 5, lines 1-3 and 20-25, Col. 6, lines 7-9, and Col. 7, lines 1-6, 11-13, 20-24, 25-27, 29-31, 31-34, 49-51 and claims 1 and 14.)

LaTorre does not disclose, teach or suggest abrasion of any tissue, including nail tissue. Only twice does LaTorre mention removal of compositions from nails. On both occasions the specification simply states that the compositions are “removed” or “wiped off.” In neither instance does the specification suggest any abrasive action associated with such removal. (In order to expedite prosecution of the instant application, applicants have excluded abrasion of

nails from the claims of the instant application. Applicants reserve the right to submit claims directed to nails in a future continuation, continuation-in-part, or divisional application.)

The secondary Ballantone reference does not cure any of the deficiencies of LaTorre recited above.

Accordingly, applicants respectfully submit that independent claim 59 is not rendered obvious by LaTorre in view of Ballantone.

Dependent Claims

For the reasons stated above with respect to independent claim 59, applicants maintain that claims 60-70 dependent thereon are likewise not rendered obvious by the cited references.

Conclusion

In view of the foregoing, applicants respectfully request that the Examiner reconsider and withdraw the rejections set forth in the December 28, 2007 Office Action and allow the presently pending claims.

No fee, other than the fee for a two-month extension of time, is believed to be necessary in connection with the filing of this Amendment. If any additional fee is deemed to be necessary, applicants hereby authorize such fee to be charged to Deposit Account No. 50-0540.

Zimmer et al.
Serial No.: 10/696,878
Filing Date: October 30, 2003

Attorney Docket No. 99866/15

If a telephone interview would be helpful to clarify any of the issues addressed above, applicants' undersigned attorney encourages the Examiner to telephone him at the number provided below.

Respectfully submitted,

Dated: May 28, 2008

/Robert E. Alderson/

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